



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/527,767

03/17/2000

Wolfgang Kreiss

LeA 33 072

3608

35969

7590

03/22/2007

JEFFREY M. GREENMAN

BAYER PHARMACEUTICALS CORPORATION

400 MORGAN LANE

WEST HAVEN, CT 06516

EXAMINER

YANG, NELSON C

ART UNIT

PAPER NUMBER

1641

MAIL DATE

DELIVERY MODE

03/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	Application No. 09/527,767	Applicant(s) KREISS ET AL.	
	Examiner Nelson Yang	Art Unit 1641	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee, under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 16 February 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

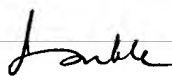
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
 See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

  
 LONG V. LE 03/15/07  
 SUPERVISORY PATENT EXAMINER  
 TECHNOLOGY CENTER 1600

Continuation of 11. does NOT place the application in condition for allowance because: applicant's arguments are not found persuasive.

With respect to applicant's argument that the prior art fails to teach a sheet of diffusion-controlling matrix comprising a biological sensor material, the material being bioluminescent cells with gene constructs, the Office fails to see which portion of the limitation that the prior art fails to address. However, the Office will attempt to address each portion of the limitation in greater detail. With respect to the diffusion controlling matrix Still et al. teach agarose, which by applicant's own specification, is a diffusion controlling material (see. claim 29). With respect to biological sensor material suspended throughout the matrix, Still et al. teach cells embedded in the gel. With respect to the limitation that the biological sensor material being cells with reporter gene constructs, Still et al. specifically teach recombinant cells with exogenous genes or exogenous transcriptional regulatory sequences that produce a fluorescent product upon binding. In particular, with respect to the last limitation it is unclear why applicant appears to believe that the recombinant cells would not be considered cells with reporter gene constructs. A reporter gene construct is merely sequence that encodes easily assayed proteins, and bioluminescence refers to converting chemical energy to light energy, which Still et al. teach. While applicant is allowed to be their own lexicographer, no definition of bioluminescence was found in the specification.

With respect to applicant's arguments that the prior art fails to teach a means for detecting the spatial distribution relative to said sheet of diffusion-controlling matrix of signals produced in the matrix by said biological sensor material when said at least one substance is in contact with at least one spatially-discrete area of said matrix, it appears that applicant is unsuccessfully trying to invoke 112, 6th paragraph. However, applicant has not defined what a means for detecting the spatial distribution relative to said sheet of diffusion-controlling matrix of signals produced in the matrix by said biological sensor material when said at least one substance is in contact with at least one spatially-discrete area of said matrix would be in the specification. If applicant did not intend to invoke 112, 6th paragraph, then since applicant has not recited any structural or physical limitations with regard to the means, then, as long as the one of ordinary skill in the art is capable of determining the spatial distribution relative to said sheet of diffusion-controlling matrix of signals produced in the matrix by said biological sensor material when said at least one substance is in contact with at least one spatially-discrete area of said matrix, then the prior art reads upon the claim, which Still et al. does. In particular, as discussed in the previous office action, Still et al. teach that when a vital dye (the substance) is spread over the gel, cells which absorb the dye or did not absorb the dye could then be distinguished. Since the cells cannot be located in the exact same place, the spatial distribution of the cells can therefore be determined, such as by looking at the matrix. In fact the grid taught by Still et al. would allow for better spatial differentiation between different signals produced by different cells. Therefore, the prior art reads upon this limitation, and applicant's arguments are not found persuasive.

With respect to applicant's argument that the Office fails to point to a single teaching or embodiment in Stills that meets each and every element of the claimed invention, the Office disagrees. In particular the Office notes that while different methods were referred to, the same product was used in each method. Since applicant is claiming a product, and not the method, applicant's argument has no basis and therefore is found completely unpersuasive. It should be noted that as long as the apparatus is capable of performing the intended uses recited, then it reads upon the recited claims.

While the heart of applicant's invention may differ from the prior art, the Office notes that the claims as currently recited are so broad as to encompass inventions taught by the prior art. Therefore, applicant's arguments are not found persuasive, and the rejections are maintained.